Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK C. DeSIMONE, ROBERT J. PIECHOWIAK, CHARLES R. MILLER, Sr., and HENRY C. NICHOLSON

Appeal No. 2001-1969
Application No. 09/040,478

ON BRIEF

Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2 through 15, 17 through 23, 27, 28, and 30 through 35. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a slot machine and to a method for operating a slot machine. A basic understanding of the invention can be derived from a reading of exemplary claims 34 and 35, respective copies of which appear in the APPENDIX to the main brief (Paper No. 13).

As evidence of obviousness, the examiner has applied the documents listed below:

Adams	5,823,874	Oct. 20, 1988
Mangano et al. (Mangano)	5,839,955	Nov. 24, 1998
Brune et al. (Brune)	5,851,148	Dec. 22, 1998

"The Joker's Wild", Jack Barry Productions, September 4, 1972-June 13, 1975 (online) Retrieved from the Internet [2000-03-08] URL<wysiwyg://45/http://www.geocities.com/Hollywood/Hills/5134/joker72.html>

The following rejections are before us for review.

Claims 32 and 33 stand rejected under 35 U.S.C. § 112, fourth paragraph, as failing to further limit the subject matter of a previous claim.

Claims 2 through 7, 11, 17 through 22, 27, 28, and 30 through 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of "The Joker's Wild."

Claims 8 through 10 and 12 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of "The Joker's Wild", further in view of Mangano.

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of "The Joker's Wild", further in view of Brune.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the supplemental answer[1] (Paper No. 19), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 13 and 15).

[1] The supplemental answer, filed pursuant to an order (Paper No. 18), remedies some formal matters and supersedes the earlier answer (Paper No. 14).

In the main brief (page 4), appellants indicate that all claims stand or fall together. Therefore, our primary focus below shall be upon independent claims 34 and 35, with the remaining claims on appeal standing or falling therewith.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims 34 and 35, the applied teachings,[2] and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

[2] In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The §112, fourth paragraph rejection

We summarily sustain this rejection of claims 32 and 33 since appellants offer no argument thereagainst. It is worthy of acknowledging that appellants indicate (main brief, page 2) that claims 32 and 33 would be canceled if the independent claims, i.e., claims 34 and 35, are determined to be patentable.

The obviousness rejections

We do not sustain the rejection of claims 34 and 35 under 35 U.S.C. § 103(a) based upon the combined teachings of Adams and "The Joker's Wild." It follows that the respective rejections under 35 U.S.C. § 103(a) of claims dependent from claims 34 and 35 are also not sustained. Our reasoning appears below.

We fully comprehend the examiner's well stated assessment of the applied teachings and views as to the obviousness of the claimed subject matter. Nevertheless, we readily perceive, as more fully discussed, infra, that the collective teachings of Adams and "The Joker's Wild", evaluated as a whole, would not have been suggestive of the content of claims 34 and 35.

Claim 34 is addressed to a slot machine comprising, inter alia, a payout device that awards a player a first award amount multiplied by a factor based on a multiplier value selected from a variable award multiplier comprising a random number generator when at least one of a plurality of symbols is a bonus symbol, the plurality of symbols representing outcomes of a game.

Claim 35 is drawn to a method for operating a slot machine comprising, inter alia, determining an award payment to a player, the award payment being a first award multiplied by an award multiplier value determined by operating a random number generator when at least one of a plurality of symbols is a bonus symbol, the plurality of symbols representing game results.

Like the examiner (supplemental answer, page 7), we readily appreciate the relevance of the Adams teaching (column 5, lines 5 through 29 and column 6, lines 37 through 52) as to the disclosure of a random value multiplier, and recognize its deficiency in not teaching or suggesting at least one bonus symbol, and the selection of a random multiplier value when at least one of a plurality of symbols is the bonus symbol, as now claimed. However, unlike the examiner, we do not view "The

Joker's Wild" disclosure as providing a suggestion for modifying the slot machine of Adams to thereby effect the claimed slot machine and method of appellants' respective claims 34 and 35. While "The Joker's Wild" game show required three rotating wheels, akin to the rotating symbol arrangement of a slot machine, clearly the game show is not a slot machine. More significantly, however, is the circumstance that an appearing Joker symbol(s) in the game show acts to either double or triple a selected category's value, or allow a player to win a game automatically when three Joker's appear. Thus, the game show teaching would not have suggested the selection of a random multiplier value when at least one of a plurality of symbols is a bonus symbol. As we see it, at best, the game show arrangement would have offered one having ordinary skill in the art the option of a bonus symbol to double (appearance of one bonus symbol) or triple (appearance of two bonus symbols) a first award value upon the appearance of one or two bonus symbols, as an alternative to the Adams random multiplier arrangement lacking bonus symbols. For the preceding reasons, we conclude that, only with appellants' own teaching in mind, would one having ordinary skill in the art have been able to achieve the claimed invention on the basis of the applied prior art. Thus, the obviousness

rejection of claims 34 and 35 cannot be sustained. As a final point, we simply note that the examiner applied the respective Mangano and Brune references for features other than the issue addressed above, and we do not perceive that these documents overcome the earlier explained deficiency of the Adams and "The Joker's Wild" disclosures.

In summary, this panel of the board has sustained the rejection of claims 32 and 33 under 35 U.S.C. § 112, fourth paragraph, but has not sustained any of the examiner's rejections under 35 U.S.C. § 103(a).

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)	

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